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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/361,626 07/27/99 MOK

F PM-262743

EXAMINER

IM22/0605

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CINTINS, I

ART UNIT

PAPER NUMBER

1724

12

DATE MAILED:

06/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/361,626

Applicant(s)

Mok et al.

Examiner

Ivars C. Cintins

Art Unit

1724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 7, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9, and 10 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9 and 10 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Nagy. As pointed out in the previous Office Action, Nagy discloses a process for removing trace amounts of aluminum from a sodium chloride brine by treating the brine with magnesium chloride to produce a magnesium concentration of at least about 5 ppm in the brine, and subsequently adding sodium hydroxide to this brine to provide an alkalinity concentration of 0.15 g/L in this brine, thereby forming a magnesium aluminum hydroxide precipitate. Accordingly, this reference discloses the claimed invention with the exception of the recited magnesium to aluminum molar ratio, and the exact magnesium concentration in the brine (i.e. less than 5 ppm). However, the exact magnesium to aluminum molar ratio in the reference process is not seen to materially affect the overall results of this process, or to produce any new and unexpected result; and is therefore deemed to be an obvious matter of

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choice, which is insufficient to patentably distinguish the claims. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a brine having a magnesium concentration slightly lower than that disclosed (e.g. 4.99 ppm) in the reference, since such a slightly lower magnesium concentration is also not seen to materially affect the overall results of the reference process, or to produce any new and unexpected result; and is therefore also deemed to be an obvious matter of choice, which is insufficient to patentably distinguish the claims.

Applicant's arguments filed March 7, 2001 have been noted and carefully considered but are not deemed to be persuasive of patentability. Applicant has presented the results of three experiments in an attempt to demonstrate new and unexpected results for the claimed process conditions. These experimental results, however, are not persuasive of patentability for claims 1-7, 9 and 10 because: (1) these results have not been submitted in proper 37 CFR § 1.132 affidavit or declaration form; and (2) the showing presented is not commensurate in scope with the limitations of claims 1-7, 9 and 10. For example, all of the claims read on a magnesium concentration up to just less than 5 ppm, but experiments 1-3 merely test Mg concentrations of 0.5, 1.0 and 2.0. It is not clear that Mg concentration values

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greater than 2.0, and still less than 5.0, will produce similar results. Also, in experiment #3 (first three runs) Applicant has apparently demonstrated that Mg/Al molar ratios of 22.2, outside the claimed range of 5-20, will produce satisfactory results. Accordingly, this test data appears to support the examiner's position that the exact magnesium to aluminum molar ratio in the reference process is an obvious matter of choice. Furthermore, since the aluminum concentration in all of experiments 1-3 is 0.5 ppm or less, and since the aluminum concentration in the reference example is always 1.0 ppm, it is not readily apparent that the test results contained in the response filed March 7, 2001 represent a fair comparison between Applicant's claimed process and that of Nagy.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee

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pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (703) 308-3840. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.

The fax phone numbers for this art unit are: (703) 305-3599 for "Official" faxes after Final Rejection; (703) 305-7718 for all other "Official" faxes; and (703) 305-3602 for "Draft" and other "Unofficial" faxes.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Ivars Cintins
Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
June 3, 2001